

REMARKS

This Amendment is filed in response to the Office Action dated October 2, 2006, which has a shortened statutory period set to expire January 2, 2007.

Claims 28, 29, And 35 Are Definite

Applicant greatly appreciates the Examiner's close reading of the claims. Applicant has amended Claims 28, 29, and 35 to address the Examiner's objections. Specifically, Claims 28 and 35, as amended, now recite, "wherein the trigger condition disables a set of features of the CAD tool until the additional payment is made". Moreover, Claim 29, as amended, now recites, "the set of features include at least one of generating a predetermined output file and running the CAD tool". Based on these amendments, Applicant requests reconsideration and withdrawal of the objection to Claims 28, 29, and 35.

Claims 26-40 Are Patentable Over Robertson

Claim 26 recites in part:

using the CAD tool, wherein the computer system running the CAD tool includes criteria for requesting at least one additional payment for the CAD tool, each additional payment being associated with generating an output, the computer system being responsive to one or more trigger conditions corresponding to the criteria; and

receiving a payment request when an output generated by the CAD tool satisfies a trigger condition, wherein the trigger condition adds a watermark to the output for identifying the output as having been produced by the CAD tool.

The Third Office Action admits that Robertson fails to teach these limitations. However, the Third Office Action then takes Official Notice and cites "common practice" in obviating

criteria for requesting an additional payment based on generating an output using the CAD tool and receiving a payment request based on the trigger condition, which is identified by a watermark in the output. Applicant respectfully submits that this Official Notice/common practice is unsupported by documentary evidence.

Specifically, Robertson uses a watermark merely to protect an IP core when it is electronically delivered to the user via the portal site. Col. 18, lines 41-58. Robertson fails to make any suggestion that a watermark can be used to trigger an additional payment based on an output of a CAD tool including the watermark. The Third Office Action provides no documentary evidence for using Official Notice/common practice to remedy the deficiency of Robertson.

According to the MPEP 2144.03, "it is never appropriate to rely solely on "common knowledge" in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based" (citing *In re Zurko*, 258 F.3d 1379, 1385-1386, Fed. Cir. 2001 (some concrete evidence must be pointed to support basic knowledge)). Indeed, general conclusions concerning what is common practice to one of ordinary skill in the art without specific factual findings and some concrete evidence in the record to support these findings will not support an obviousness rejection. *Zurko*, 258 F.3d at 1386.

Applicant challenges the assertion that the recited steps of using the CAD tool and receiving the payment request are common practice. As noted above and admitted in the Third Office Action, Robertson fails to teach either of these steps. No other concrete evidence is provided to support the obviousness rejection. Therefore, it is inappropriate for the Examiner to take Office Notice of these recited steps.

Because Official Notice (or common practice) cannot be used to remedy the deficiency of Robertson with respect to the steps of using the CAD tool and receiving the payment request, Applicant requests reconsideration and withdrawal of the rejection of Claim 26.

Claims 27-32 depend from Claim 26 and therefore are patentable for at least the reasons presented for Claim 26. Based on those reasons, Applicant requests reconsideration and withdrawal of the rejection of Claims 27-32.

Claim 33 recites:

entering criteria for requesting at least one additional payment for the CAD tool into a computer system running the CAD tool, each additional payment being associated with the CAD tool generating an output, the computer system being responsive to one or more trigger conditions corresponding to the criteria; and

generating a payment request when an output generated by the CAD tool satisfies a trigger condition.

Therefore, Claim 33 is patentable for substantially the same reasons presented for Claim 26. Based on those reasons, Applicant requests reconsideration and withdrawal of the rejection of Claim 33.

Claims 34-39 depend from Claim 33 and therefore are patentable for at least the reasons presented for Claim 33. Based on those reasons, Applicant requests reconsideration and withdrawal of the rejection of Claims 34-39.

Claim 40 recites:

running the CAD tool on a computer system, the CAD tool specifying a trigger condition for requesting a second payment, the first and second payments representing a purchase price related to the CAD tool and specified by the contract, the trigger condition including producing the output data file using the CAD tool;

producing the output data file by the CAD tool user using the CAD tool, wherein the CAD tool automatically adds a watermark to the output data file to identify the output data file as having been produced with the CAD tool, wherein the watermark includes at least one of a naming convention, non-functional data, a spacing convention, and an ordering convention that indicates the trigger condition, wherein the computer system automatically detects the watermark; and

upon detection of the watermark, receiving a request for the second payment by the CAD tool user in accordance with the contract.

Therefore, Claim 40 is patentable for substantially the same reasons presented for Claim 26. Based on those reasons, Applicant requests reconsideration and withdrawal of the rejection of Claim 40.

CONCLUSION

Claims 26-40 are pending in the present application.
Allowance of these claims is respectfully requested.

If there are any questions, please telephone the
undersigned at 408-451-5907 to expedite prosecution of this
case.

Respectfully submitted,

Customer No.: 35273

/Jeanette S. Harms/
Jeanette S. Harms
Attorney for Applicants
Reg. No. 35,537